

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,684,138: PAVERCAT
Registered on the Principal Register on February 4, 2003, in International Class 7

TTAB

CATERPILLAR INC.,

Petitioner,

v.

PAVE TECH, INC.,

Registrant.

Cancellation No. 41,776

06-15-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

CERTIFICATE UNDER 37 C.F.R. 1.10:

'Express Mail' mailing number: EL984580743 US

Date of Deposit: 6/15/04

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 and is addressed to: Box TTAB, 2900 Crystal Drive, Arlington VA 22202.

By:

Rebecca J. Bishop
Rebecca J. Bishop

**PAVE TECH'S REPLY IN SUPPORT OF ITS
MOTION TO QUASH AND FOR PROTECTIVE ORDER**

Caterpillar has presented no valid grounds for allowing the depositions of Glen Wroblewski and Dale Sopkowiak to proceed. Despite Caterpillar's efforts to muddy the waters, the facts are quite simple. Pursuant to 37 CFR §2.120(a), discovery depositions must be *noticed and taken* on or before the closing date of the discovery period. The closing date of discovery in this case was May 5, 2004. Exhibit A. Caterpillar noticed the deposition of Mr. Wroblewski to be taken on May 12, 2004 and Mr. Sopkowiak to be taken on May 14, 2004. Exhibit B. Clearly, these depositions were not timely noticed, and Pave Tech's Motion to Quash and For Protective Order should be granted.

The only excuse Caterpillar has offered for its failure to timely notice the above-referenced depositions is to falsely claim that counsel for Pave Tech "reneged on its agreement to extend the discovery period." This simply is not true. Exhibit C-D. Indeed, Pave Tech never agreed to extend the discovery period in this case. Further, Pave Tech deeply regrets not only Caterpillar's quite personal false accusations, but also Caterpillar's decision to involve the Board in what amounts to a very simple discovery matter.

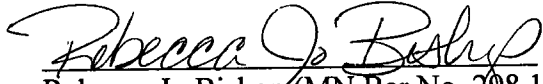
Accordingly, Pave Tech respectfully requests that the Board grant Pave Tech's Motion to Quash and for Protective Order.

Respectfully submitted,

PAVE TECH, INC.

By its attorneys,

Dated: 6/15, 2004


Rebecca Jo Bishop (MN Bar No. 298,165)
Karen D. McDaniel (MN Bar No. 194,554)
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6500 City West Parkway
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Michael J. O'Loughlin (MN Bar No. 81,607)
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Minneapolis, MN 55415
Telephone: (612) 342-0351
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Exhibit A

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,684,138: PAVERCAT
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,

Petitioner,

v.

PAVE TECH, INC.,

Respondent.

75/904,827

Cancellation No. 41,776

03-01-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

CONSENTED MOTION TO EXTEND DISCOVERY AND TESTIMONY PERIODS

Petitioner hereby moves to extend the discovery period and all subsequent testimony periods for thirty (30) days in the above proceeding as follows:

Discovery Period to close:

May 5, 2004

30-day testimony period for party in
position of Plaintiff to close:

August 5, 2004

30-day testimony period for party in
position of defendant to close:

October 4, 2004

15-day rebuttal testimony period for
plaintiff to close:

November 17, 2004

The parties are responding to written discovery requests. This additional time is necessary to exchange documents, prepare for the depositions, and complete discovery before proceeding with the testimony period.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington Virginia 22202-3514 on February 25, 2004.

Deana Perez

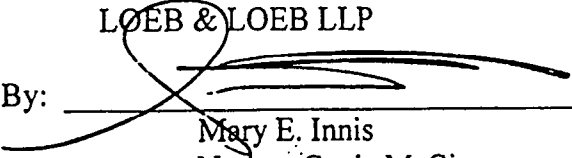
The parties respectfully submit that this constitutes good cause for the requested extension. Respondent's attorney, Michael J. O'Loughlin, consented to this extension via telephone on February 25, 2004.

Respectfully submitted,

LOEB & LOEB LLP

Date: February 25, 2004

By: _____


Mary E. Innis
Nerissa Coyle McGinn
200 South Wacker Drive
Suite 3100
Chicago, Illinois 60606
Telephone: (312) 674-4780
Facsimile: (312) 674-4779

CERTIFICATE OF SERVICE

I, Nerissa Coyle McGinn, hereby certify that I caused a copy of the foregoing
CONSENTED MOTION TO EXTEND DISCOVERY AND TESTIMONY PERIODS to
Michael J. O'Loughlin, Micheal J. O'Loughlin & Associates, P.A., 400 South 4th Street, 1012
Grain Exchange Building, Minneapolis, Minnesota 55415 by first class mail, postage prepaid on
February 25, 2004.

A handwritten signature in black ink, appearing to read "Nerissa Coyle McGinn", is written over a horizontal line.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: March 20, 2004

Opposition No. 92041776

CATERPILLAR INC.

v.

Pave Tech, Inc.

ANGELA CAMPBELL, PARALEGAL SPECIALIST:

Opposer's/Applicant's consented motion filed March 1,
2004 to extend discovery and trial dates is granted.
Trademark Rule 2.127(a).

The discovery and trial dates are reset in accordance
with opposer's/applicant's motion.

Exhibit B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,684,138: PAVERCAT
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,)	
)	
Petitioner,)	
v.)	Cancellation No. 41,776
)	
PAVE TECH, INC.,)	
)	
Registrant.)	

NOTICE OF DEPOSITION

TO: Michael J. O'Loughlin
Michael J. O'Loughlin & Associates, P.A.
1012 Grain Exchange Building
400 South 4th Street
Minneapolis, MN 55415

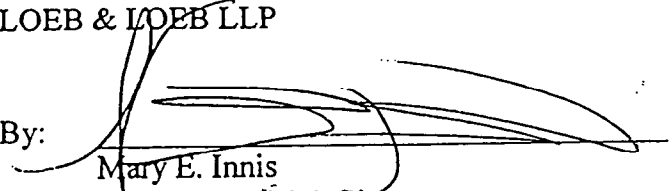
On Wednesday, May 12, 2004, beginning at 9:30 am, Petitioner, Caterpillar Inc., will depose the person identified below before a court reporter or other person qualified to administer oaths. The depositions will take place at Brown and James Reporting, 312 E. Wisconsin Avenue, Suite 608, Milwaukee, WI 53202 and continue until completed. The deposition shall be recorded by means chosen by Petitioner. The deponent shall be the following:

1. Glen Wroblewski

Dated: April 28, 2004

LOEB & LOEB LLP

By:

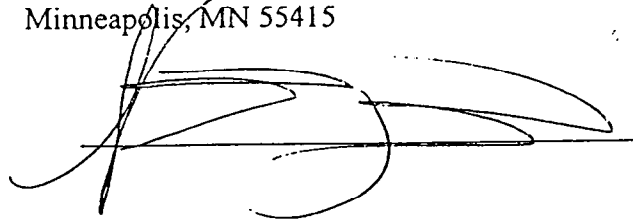

Mary E. Innis
Nerissa Coyle McGinn
200 South Wacker Drive, Suite 3100
Chicago, Illinois 60606
Telephone: (312) 674-4780
Facsimile: (312) 674-4779

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that true and correct copy of the foregoing
AMENDED NOTICE OF DEPOSITION was served via facsimile and U.S. Mail on April 28,
2004 to the following counsel of record:

Michael J. O'Loughlin
Michael J. O'Loughlin & Associates, P.A.
1012 Grain Exchange Building
400 South 4th Street
Minneapolis, MN 55415

A handwritten signature in dark ink, appearing to be "M. J. O'Loughlin", written over a horizontal line.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,684,138: PAVERCAT
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,)	
)	
Petitioner,)	
v.)	Cancellation No. 41,776
)	
PAVE TECH, INC.,)	
)	
Registrant.)	

NOTICE OF DEPOSITION

TO: Michael J. O'Loughlin
Michael J. O'Loughlin & Associates, P.A.
1012 Grain Exchange Building
400 South 4th Street
Minneapolis, MN 55415

On Friday, May 14, 2004, beginning at 9:30 am, Petitioner, Caterpillar Inc., will depose the person identified below before a court reporter or other person qualified to administer oaths. The depositions will take place at Lindquist & Vennum P.L.L.P., 4200 IDS Center, 80 South 8th Street, Minneapolis, MN 55402 and continue until completed. The deposition shall be recorded by means chosen by Petitioner. The deponent shall be the following:

1. Dale Sapkowiak

Dated: April 28, 2004

LOEB & LOEB LLP

By: _____

Mary E. Innis
Nerissa Coyle McGinn
200 South Wacker Drive, Suite 3100
Chicago, Illinois 60606
Telephone: (312) 674-4780
Facsimile: (312) 674-4779

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that true and correct copy of the foregoing
AMENDED NOTICE OF DEPOSITION was served via facsimile and U.S. Mail on April 28,
2004 to the following counsel of record:

Michael J. O'Loughlin
Michael J. O'Loughlin & Associates, P.A.
1012 Grain Exchange Building
400 South 4th Street
Minneapolis, MN 55415

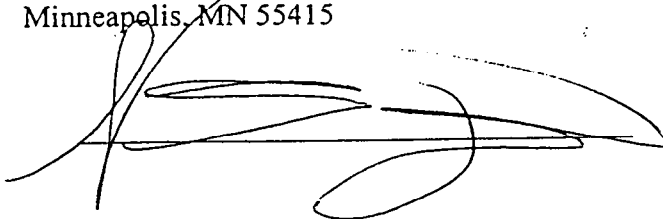
A handwritten signature in black ink, appearing to be "Michael J. O'Loughlin", written over the printed name and address.

Exhibit C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,684,138: PAVERCAT
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CATERPILLAR INC.,

Petitioner,

V.

PAVE TECH, INC.,

Registrant.

Cancellation No. 41,776

DECLARATION OF REBECCA J. BISHOP

1. I am an attorney with Altera Law Group, LLC, 6500 City West Parkway, Suite 100, Eden Prairie, MN 55344. Steve Jones, President of Pave Tech, Inc. ("Pave Tech") recently retained Altera Law Group to work in conjunction with Michael J. O'Loughlin in the above-identified matter. I am the primary attorney at Altera Law Group involved in this matter.

2. This declaration is being offered to support Pave Tech's Response to Caterpillar's Motion for Protective Order and Pave Tech's Response to Caterpillar's Motion for Extension of Discovery and Testimony Periods. I have personal knowledge of the facts set forth herein and can testify competently hereto.

3. The substance of this declaration is expressly limited to the issue of whether I orally stipulated to an extension of the discovery deadline past May 5, 2004. By declaring as follows, I do not intend to reveal any client confidences in violation of Pave Tech's attorney-client privilege. To the extent this declaration may necessarily reveal such confidences, any

breach to Pave Tech's attorney-client privilege is limited to the specific issue of my discussions with Pave Tech regarding a stipulation to an extension of the discovery period past May 5, 2004.

4. At no time prior to April 29, 2004 did I receive authority from Pave Tech to agree to an extension of the discovery period, as requested by Caterpillar. Given that I was brought into this case fairly recently and my knowledge of the case is new, I was extremely careful to discuss all aspects of this case with my client and to receive full authority to act on behalf of my client before taking any actions in the case. Moreover, I was extremely careful to relay to counsel for Caterpillar that I did not have authority to act on behalf of my client when I, indeed, did not yet have authority. As detailed below, I specifically told counsel for Caterpillar, several times, that I could not agree to an extension of time until I discussed the matter with my client.

5. On April 21, 2004, Pave Tech served three deposition notices on Caterpillar, noticing depositions to be taken on May 3, 4 and 5, 2004. I note that by order of the Trademark Trial and Appeal Board, the discovery period in this matter was set to close on May 5, 2004.

6. On April 22, 2004, I received an e-mail from counsel for Caterpillar stating as follows:

Please be advised that both Ms. McGinn and I are out of the office. I do know, however, that we will need to reschedule the depositions as both Nerissa and I are out of the office May 1-7. In addition, I believe that we will need to agree to extend the discovery period to schedule the depositions and further depositions on our end. We also might want to discuss some settlement options. I will call you today if I am able or tomorrow to discuss further.

7. Shortly thereafter, I telephoned Steve Jones, President of Pave Tech, Inc., to discuss the advantages and disadvantages of stipulating to an extension of the discovery period in this case. Mr. Jones instructed me to call counsel for Caterpillar to get more details about their

request so that he could make a more informed decision. Specifically, Mr. Jones did not authorize me to agree to an extension of the discovery period.

8. For the next week, I diligently attempted to contact counsel for Caterpillar to no avail. On April 27, 2004, I finally spoke with Nerissa Coyle McGinn, counsel for Caterpillar, regarding the deposition schedules, settlement and Caterpillar's request for an extension of time. Ms. McGinn indicated that Caterpillar wanted a 60-day extension of time in order to take depositions in addition to the two depositions it had already conducted in February. With respect to Caterpillar's request for an extension of the discovery period, I indicated that 60 days sounded a bit excessive, but 30 days was perhaps a more realistic request. As my client had not given me authority to agree to a stipulation of *any* duration, *I specifically stated*, "60 days sounds excessive, I have no problem with 30 days, but *I cannot agree to anything without discussing this with my client first.*" To be clear, I explicitly stated at least one more time during this conversation that I could not agree to an extension of the discovery period before speaking with my client. Ms. McGinn indicated that Caterpillar would be sending additional information to Pave Tech very shortly, perhaps within a day or two.

9. Immediately thereafter, I called my client to relay the information obtained during the telephone call with Caterpillar. I reiterated to Mr. Jones that Caterpillar's request for a 60-day extension sounded excessive, 30 days sounded a bit more reasonable, but that the ultimate decision rested with Pave Tech. Mr. Jones stated that he wished to reserve making a final decision until we received the additional information from Caterpillar.

10. Two days later, on April 29, 2004, I received a fax from Caterpillar that included two Notices of Deposition to be taken outside of the discovery period, despite the fact that Pave Tech had not stipulated to an extension of the discovery period. Mr. Jones happened to be in

Altera's offices at that time, so I discussed the fax with my client and Ms. McDaniel immediately. Given the untimely deposition notices of Caterpillar coupled with the outstanding issue of Pave Tech's timely-noticed depositions that needed to be rescheduled, Ms. McDaniel and I suggested we discuss the matter further. My client instructed me to call him that afternoon to make a final decision.

11. When I spoke with Mr. Jones that afternoon, he was clear that he did not wish to agree to an extension of time. Mr. Jones authorized me to contact Caterpillar to relay his final decision and to discuss with Caterpillar alternate dates for Pave Tech's timely-noticed depositions.

12. I then called Ms. McGinn and stated that Pave Tech would not stipulate to an extension of the discovery period. In response, counsel for Caterpillar surprisingly argued that I had somehow already agreed to at least a 30-day extension. I was completely surprised by this allegation. Given the fact that Caterpillar could not take additional depositions without this extension, it was clear that Caterpillar had twisted my words to suit its case and was attempting to coerce me into an extension to which I had distinctly refused. I reminded Ms. McGinn of my specific statement during our earlier conversation that I could not agree to an extension of time without speaking with my client first.

13. In addition, I reminded Ms. McGinn that Pave Tech had timely noticed three depositions for the following week, May 3-5, 2004. Ms. McGinn indicated that counsel for Caterpillar was going to a trademark conference and could not attend. As a courtesy, I offered to unilaterally extend the discovery period so these depositions could be taken at a more convenient time for Caterpillar. Ms. McGinn stated that she would contact me the following day with alternate dates.

14. On April 30, 2004, instead of receiving alternate dates for the Pave Tech depositions, we were served with Caterpillar's Motion for Protective Order and Motion for Extension of Discovery and Testimony Periods.

15. None of the people Pave Tech had noticed for deposition appeared at the required place or time on May 3, 4 or 5, 2004.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: May 11, 2004

Rebecca J. Bishop

Rebecca J. Bishop

Exhibit D

4. The substance of this declaration is expressly limited to the issue of Rebecca J. Bishop's authority to stipulate to an extension of the discovery period past May 5, 2004. By

declaring as follows, I do not intend to waive my attorney-client privilege. To the extent this declaration may operate as such, I am only waiving my attorney-client privilege with respect to the sole issue of my discussions with Ms. Bishop regarding a stipulation to an extension of the discovery period past May 5, 2004.

5. At no time did I ever give Ms. Bishop authority to grant any extensions of the discovery period in this matter without my express instruction. Given Ms. Bishop's recent appearance in this matter, I expected her to, *and she did*, come to me for approval on all significant decisions in this matter, including whether to allow Caterpillar an extension of time to take further depositions of my organization.

6. I was deposed in connection with this matter on February 23, 2004. At the time of my deposition, counsel for Caterpillar indicated that it was interested in discussing settlement, and that it would be sending a settlement proposal "shortly."

7. Based on this representation from Caterpillar's counsel, I instructed my counsel to wait to serve deposition notices.

8. Nearly two months later, Caterpillar had failed to send any sort of settlement offer. As the discovery period in this action was coming to a close, I instructed my outside counsel to serve deposition notices on Caterpillar, such notices being served on April 21, 2004. Had Caterpillar not misrepresented that it would be sending a settlement proposal in February, I would have instructed my counsel to serve deposition notices much earlier.

9. On April 22, 2004, Rebecca Bishop informed me that counsel for Caterpillar contacted her via e-mail earlier that day. Ms. Bishop explained that Caterpillar apparently wished to discuss an extension of the discovery period. We discussed the pros and cons of stipulating to such an extension, and I instructed Ms. Bishop to contact Caterpillar and get more

details about their request before I would make a final decision. Specifically, Ms. Bishop stated that she would make clear to Caterpillar that she had to consult with me before agreeing to any type of extension of time.

10. On April 27, 2004, Ms. Bishop informed me that, after playing phone tag with counsel for Caterpillar for several days, she was finally able to reach Caterpillar's counsel by telephone, at which time counsel for Caterpillar requested a 60-day extension of time. Ms. Bishop stated that she had responded by saying that 60 days sounded excessive, 30 days sounded more reasonable, but that she needed to check with me before agreeing to any sort of extension, exactly as I had instructed. I was not inclined to give Caterpillar an extension, but I decided to wait before coming to a final decision.

11. Two days later, on April 29, 2004, I was at Altera's offices when a fax was delivered to Ms. Bishop from Caterpillar. Based on a review of these materials and further discussion with Ms. Bishop and Karen McDaniel, I again indicated I did not wish to stipulate to an extension of the discovery period. Ms. Bishop and Ms. McDaniel suggested that they discuss some alternative courses of action for proceeding before I made a final decision, and that we would speak again in a few hours.

12. Ms. Bishop called me that afternoon. For a host of reasons, I came to the final decision that Pave Tech did not wish to stipulate to any further extensions of time. I instructed Ms. Bishop to contact counsel for Caterpillar immediately to relay my final decision.

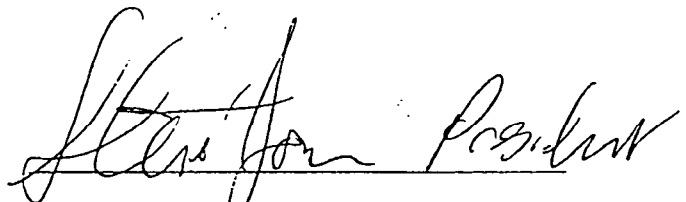
13. Later that same afternoon, Ms. Bishop called me to confirm that she had spoken with counsel for Caterpillar and that she had relayed my final decision. She further stated, surprisingly, that Caterpillar had responded by claiming we had already agreed to an extension of

time two days earlier on April 27, 2004. Ms. Bishop sounded as shocked as I was at Caterpillar's assertion.

14. I certainly never agreed to an extension of time of the discovery period. Based on my discussions with Ms. Bishop, it is clear to me that she never intended to grant such an extension, nor did she actually grant an extension.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: May 11, 2004

A handwritten signature in cursive script, appearing to read "Steve Jones", written over a horizontal line.

Steve Jones, President of Pave Tech, Inc.


CERTIFICATE OF SERVICE

I, Rebecca J. Bishop, hereby certify that on this 15th day of June, 2004, a true and correct copy of the foregoing document, PAVE TECH'S REPLY IN SUPPORT OF ITS MOTION TO QUASH AND FOR PROTECTIVE ORDER, including all Exhibits, was served via first class U.S. mail, postage prepaid, on:

Mary E. Innis
Nerissa Coyle McGinn
LOEB & LOEB LLP
200 South Wacker Drive
Suite 3100
Chicago, Illinois 60606
(312) 674-4780
(312) 647-4779 (fax)

and by facsimile on:

Michael J. O'Loughlin
MICHAEL J. O'LOUGHLIN & ASSOC. P.A.
400 South 4th Street
1012 Grain Exchange Building
Minneapolis, MN 55415
(612) 342-0351
(612) 342-2399 (fax)



Rebecca J. Bishop